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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,718	02/13/2002	Shubh D. Sharma	70025-02-US02	9717
5179	7590	04/01/2005	EXAMINER	
PEACOCK MYERS AND ADAMS P C			RUSSEL, JEFFREY E	
P O BOX 26927			ART UNIT	
ALBUQUERQUE, NM 871256927			PAPER NUMBER	

1654

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/049,718	Applicant(s) SHARMA ET AL.	
	Examiner Jeffrey E. Russel	Art Unit 1654	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See attachment.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: 31,39 and 40.
Claim(s) rejected: 2,7,8,18,20,26-30,32,33,37 and 38.
Claim(s) withdrawn from consideration: 1,3-5,9-17,19,21-25,34-36 and 41-63.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____

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1. The proposed amendment combining the limitations of dependent claims 7 and 8 with independent claim 1 raises new issues requiring further consideration and/or search. The proposed combination of limitations has not previously been presented. While the proposed amendment would overcome the rejection over the Fabris et al article (Inorganic Chemistry, Vol. 38, pages 1322-1325), further search of the claimed invention would then be required, including search of the non-elected species of claim 18.

2. The declaration by Sharma under 37 CFR 1.132 filed March 7, 2005 shows that the Shi et al abstract (Abstracts Of Papers, American Chemical Society, 218th ACS National Meeting, Part 1, Abstract MFDI 257) is not “by another” and is therefore unavailable as prior art under 35 U.S.C. 102(a). Accordingly, the rejection set forth in section 6 of the final Office action is withdrawn.

3. The rejection over the Giblin et al article (PNAS, Vol. 95, pages 128 14-128 18) set forth in section 7 of the final Office action is maintained. With respect to APOMSH and ReMSH, Applicants point to page 12816, second column, first full sentence, of the Giblin et al article as showing that the peptide is less specific towards one or more melanocortin receptors when complexed with rhenium. However, as acknowledged by Applicants at page 2, lines 3-8, of the specification, there are at least five melanocortin receptor types and subtypes. That the peptide of the Giblin et al article when complexed with rhenium is less specific towards one of these receptors does not contradict the limitation of claim 8, which only requires that it be more specific towards one unspecified melanocortin receptor. Applicants have not provided evidence that there is no melanocortin receptor towards which APOMSH/ReMSH peptide of the Giblin et al article is substantially more specific when in the rhenium-complexed state. With respect to

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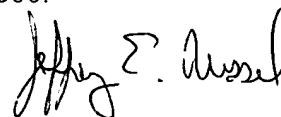
CCMSH and ReCCMSH, Applicants contend that Figure 1 and the paragraph bridging pages 12816 and 12817 show that the metal ion-binding domain and the biological function domain are separate from one another and are not coextensive as required by Applicants' claims. However, Applicants have not explained why the two domains present in CCMSH are not "co-extensive" as defined by Applicants. In particular, Applicants' argument assumes that biological-function domain of CCMSH is limited to the His-DPhe-Arg-Trp residues. It does not appear that the claim terminology "biological-function domain" is explicitly defined in Applicants' specification. (At page 16, line 18 - page 17, line 2, Applicants define a "biological-binding domain".) However, it would not be expected that the residues present in CCMSH in addition to the His-DPhe-Arg-Trp residues have no effect on the biological function (or for that matter, on the biological binding) of the peptide, and thus the "co-extensive" claim limitation appears to be met by the prior art. In view of the similarity in structure and function between the peptides of the Giblin et al article and Applicants' claimed peptides, a prima facie case of anticipation is deemed to exist. This prima facie case is not rebutted by the inferences made by Applicants.

4. The examiner maintains his position with respect to the effective filing date of the instant claims. The refusal to accord the benefit of the filing date of the provisional application is largely based upon the fact that the concept of coextensive biological-function and metal ion-binding domains is not disclosed in the provisional application, either explicitly or using equivalent terminology, and upon the fact that the disclosure of a limited number of species does not inherently or implicitly disclose a more general class of compounds.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Bruce Campell can be reached at (571) 272-0974. The fax number for formal communications to be entered into the record is (571) 273-8300; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.

A handwritten signature in black ink, appearing to read "Jeffrey E. Russel". The signature is stylized with a large, looped "J" and "R".

Jeffrey E. Russel

Primary Patent Examiner

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JRussel

March 21, 2005